

### **REMARKS**

Claims 1-32 are pending in the application. Claims 5, 14-16, 18, and 20-22, and 25 have been cancelled by this amendment. Therefore, claims 1-4, 6-13, 17, 19, and 23-32 are at issue.

Claim 1 has been amended to recite that (a) the browning agent is capable of undergoing a Maillard reaction with meat proteins (see original claim 5), (b) the viscosity-modifying agent comprises a water-soluble cellulose ether (see original claim 16 and specification, page 15, lines 19-20), and (c) the composition contains a polyol. In addition, the functional language of claim 1 has been deleted.

Claim 17, 29, 23, and 24 have been amended to conform in scope to claim 1. The feature of the composition containing a surfactant has been deleted from the claims to facilitate prosecution, as opposed to reasons related to patentability. Claim 10 has been amended to improve the form of the claim.

Independent claim 1 recites a composition comprising specifically claimed amounts of a browning agent, a water-soluble cellulose ether viscosity-modifying agent, a polyol, an optional salt, and water. Claim 2 recites the presence of an optional flavoring agent, and claim 11 recites the presence of an optional coloring agent that is *incapable* of undergoing a Maillard reaction with meat proteins. Claim 24 recites a preferred embodiment of the present invention.

Claims 19-23 stand objected to for reciting a “method” rather than a “composition”. Applicants apologize for this inadvertent error, and have amended claims 19 and 23 to correct the error. The objection is moot as to claims 20-22 because these claims have been cancelled by this amendment.

Claim 8 also is objected to. In response, the dependency of claim 8 has been amended to depend from claim 1. Claim 7 also has been amended to recite “an aldehyde” to overcome any confusion relating to claim 8. However, it is well understood that the terminology “comprises an aldehyde” does not limit the claim to a single aldehyde, e.g.,

when the browning agent comprises two or more aldehydes, the browning agent still “comprises an aldehyde”.

In view of the amendments to claims 7, 8, 19, and 23, it is submitted that all claim objections have been overcome and should be withdrawn.

Claims 1-32 also stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite. In view of the amendments to the claims, it is submitted that this rejection has been overcome and should be withdrawn. In particular, claim 1 has been amended to delete the functional language of “capable of”. Claim 7 has been amended to recite “an aldehyde” and clarify the claim, as discussed above. Claim 23 and 24 have been amended to correct a typographical error and recite “polyol”, as recited in claim 1, in place of “glycol”.

In view of these amendments, it is submitted that claims 1-32 fully comply with 35 U.S.C. §112, second paragraph, and that the rejection should be withdrawn.

Claims 1-32 stand rejected under 35 U.S.C. §103(a) as being unpatentable over WO 02/10034 (WO ‘034). Claims 1-32 also stand rejected under 35 U.S.C. §103(a) as being unpatentable over WO ‘034 in view of Jon et al. U.S. Patent No. 6,143,344 (‘344). In view of the amendments to the claims, and for the reasons set forth below, it is submitted that these rejections are in error and should be withdrawn.

The establishment of a *prima facie* case of obviousness is set forth in the MPEP §2143 stating:

**"2143 Basic Requirements of a *Prima Facie* Case of Obviousness**

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."

To establish a *prima facie* case of obviousness, *all three* requirements recited in MPEP §2143 must be satisfied: (1) the prior art reference or combination of references must teach or suggest *all the limitations* of the claims to those of ordinary skill in the art. See *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970) ("All words in a claim must be considered in judging the patentability of that claim against the prior art."); (2) the prior art relied upon must contain some suggestion or incentive, coupled with knowledge generally available in the art at the time of the invention, that would have motivated those of ordinary skill in the art to modify a reference or combine the references. See, *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1385, 58 USPQ2d 1286, 1293 (Fed. Cir. 2001) ("in holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in a way that would produce the claimed invention."); *and* (3) the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made.

To reach a proper determination under 35 U.S.C. § 103(a), the examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. Knowledge of applicants' disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the "differences," conduct the search, and evaluate the "subject matter as a whole" of the invention. The tendency to resort to "hindsight" based upon applicants' disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the *facts* gleaned from the prior art. MPEP § 2142.

The “suggestion or motivation” criterion has been addressed by the Supreme Court in the recent *KSR Int’l Co. v. Teleflex*, ---U.S.---, No. 04-1350 (U.S. Apr. 30, 2007) decision. The mandate of the United States Supreme Court in this decision is that the Patent Office must make it clear in the record that the teaching-suggestion-motivation to modify the reference exists. As emphasized by the Supreme Court, “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int’l Co. v. Teleflex, Inc.*, ---U.S.---, No. 04-1350, slip op. at 14 (April 30, 2007).

The *KSR* decision also was the subject of a May 3, 2007 memorandum from the Deputy Commissioner for Patent Operations, which stated that the four factual inquiries of *Graham* were reaffirmed by the Court and that although the Court rejected a rigid application of the “teaching, suggestion, or motivation” test, the Court *did not* totally reject the “teaching, suggestion, or motivation” test. In discussing the *KSR* decision, the May 3, 2007 memorandum further stated at page 2 (emphasis in original):

“(4) The Court noted that the analysis supporting a rejection under 35 U.S.C. § 103(a) should be made explicit, and that it was “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. The Court specifically stated:

Often, it will be necessary...to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an **apparent reason** to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis **should be made explicit**.

*KSR*, slip op. at 14 (emphasis added).

**Therefore, in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in**

**the art would have combined the prior art elements in the manner claimed.”**

WO ‘034 fails to establish a *prima facie* case of obviousness over present claims 1-32. WO ‘034 is relied upon for disclosing a composition for application to a food packaging film that contains a browning agent, smoke flavor, a viscosity-modifying agent, a surfactant, and water. The browning agent can be hydroxyacetaldehyde (HAA).

The WO ‘034 reference generally teaches a liquid that “has a sufficiently high viscosity” (page 14, lines 9 through page 15, line 2). However, a full reading of these paragraphs clearly shows that the liquid having a high viscosity is added to a susceptor *prior* to a dry browning or flavoring composition in order to keep the *dry* composition adhering to the susceptor. No specific, or even general class, of viscosity increasing agent is disclosed in WO ‘034. In addition, the presently claimed composition is a liquid. At page 11, line 30 through page 12, line 10, WO ‘034 discloses other optional composition ingredients including gums, thickeners, and other ingredients. Again, no specific viscosity-modifying agents are disclosed in the reference.

In contrast, the present claims recite a specific amount of a specific class of viscosity-modifying agent, which is neither taught nor suggested in WO ‘034.

With respect to the disclosure of a surfactant in WO ‘034, the present claims have been amended to delete the presence of a surfactant as a claimed element. The present claims, in contrast to WO ‘034, recite the presence of a specific amount of a polyol. WO ‘034 fails to teach or suggest the presence of a polyol, or provide any apparent reason for substituting a polyol for the disclosed surfactant, or to even include a polyol in the composition.

Overall, numerous differences exist between the presently claimed composition and WO ‘034. WO ‘034 fails to teach or suggest (a) the class and amount of presently claimed viscosity-modifying agent or (b) an amount or even the presence of a polyol, let alone all of these recited features. WO ‘034 simply does not provide the incentive to make the numerous jumps in reasoning that are required to arrive at the presently claimed invention from a reading of WO ‘034. In short, the reference provides no apparent reason to

modify the teachings of WO '034 to combine the disclosed ingredients, and *add undisclosed* ingredients, in a way that renders the present claims obvious.

With respect to claims 31 and 32, WO '034 is directed to a browning composition applied to a susceptor for use in a microwave heating operation. The susceptor, at most, is in minimal contact with the foodstuff. Claims 31 and 32 are directed to an encased food stuff, e.g., a sausage. The features of claim 32 are not remotely disclosed in WO '034.

Accordingly, it is submitted that pending claims 1-4, 6-13, 17, 19, and 23-32 would not have been obvious to a person skilled in the art over WO '034, and that this rejection should be withdrawn. The WO '034 reference fails to meet *all three* of the basic requirements needed to establish a *prima facie* cases of obviousness. The WO '034 reference (a) fails to teach or suggest *all* the features of the claims, e.g., the presence of a polyol, (b) provides no motivation or incentive to modify the reference as suggested by the examiner, and (c) provides no reasonable expectation of success after making the proposed modifications.

A combination of WO '034 and the '344 patent also fails to render the present claims obvious. WO '034 has been discussed above, and the '344 patent fails to cure the deficiencies of WO '034.

The '344 patent is directed to a bixin colorant composition. Bixin is an entirely different type of browning agent from those presently claimed, i.e., a coloring agent that undergoes a Maillard reaction with meat proteins. Bixin colors a food product by staining the meat, i.e., like a paint, rather than reacting with meat proteins. See '344 patent, column 6, lines 56-66; column 8, lines 8-16; column 9, lines 8-27; column 13, lines 3-10; and column 14, lines 11-18; for example.

Although bixin and other staining-type compounds are recited in present claim 11, these are optional, nonessential compounds in an alternate embodiment of the invention. As such, applicants do not rely upon these compounds as the sole point of patentability for claim 11, but rely upon these compounds and all of the features of claim 1 from which claim 11 depends.

As to the ingredients disclosed in the '344 patent, it first must be noted that the reference is directed to a different type of browning composition, i.e., a bixin dispersion in a water-soluble and/or alcohol-soluble film forming agent. Accordingly, the ingredients present in a bixin-containing composition in general, and a '344 composition in particular, are not necessarily the same as those in a presently claimed composition. For example, bixin is not water soluble, and the present composition is water based. Obviously, different composition ingredients are needed for a bixin-containing composition than for a water soluble browning agent. More specifically, as stated above, the '344 patent is directed to bixin containing compositions, which are different from an aqueous browning agent composition as recited in claim 1.

With respect to the viscosity-modifying agent disclosed at column 3, line 9 of the '344 patent, this disclosure is from a prior art reference to the '344 patent. This composition has a continuous oil or edible fat phase, as opposed to the aqueous composition that presently is claimed. Also, the bixin containing compositions of the '344 patent do not include a claimed viscosity-modifying agent, and the '344 reference provides no apparent reason to use a claimed viscosity-modifying agent.

The '344 patent also teaches the importance of a salt, particularly a phosphate, in the development of a suitable color (see '344 patent, column 14, lines 11-18, for example). The present claims recite the optional presence of a salt in an alternate embodiment. A salt is not needed to enhance color because of the substantial differences between the '344 patent bixin composition and the presently claimed browning agent composition.

In summary, the '344 patent in combination with WO '034 fails to render the present claims obvious. The two cited references each are directed to entirely different types of browning compositions that perform *via* different mechanisms. As a result, persons skilled in the art would not have had any motivation to mix and match ingredients recited in the two cited references. For example, ingredients utilized in one reference (i.e., the '344 patent using water-insoluble bixin) may be detrimental to compositions disclosed in the second reference (i.e., WO '034 using water-soluble MAILLOSE®). The deficiencies of WO '034 are discussed above, and the '344 patent fails to overcome the deficiencies. This combination of references provides no incentive to use the ingredients in a bixin containing composition

with any reasonable expectation of providing a useful composition containing a browning agent that is capable of undergoing a Maillard reaction with meat proteins.

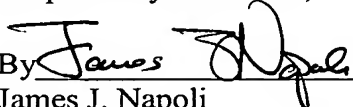
For all the reasons set forth above, it is submitted that claims 1-4, 6-13, 17, 19, and 23-32 are patentable over a combination of WO '034 and the '344 patent, and that the rejection should be withdrawn.

The present claims are in a form and scope for allowance. An early and favorable action on the merits is respectfully requested.

Should the examiner wish to discuss the foregoing, or any matter of form in an effort to advance this application toward allowance, the examiner is urged to telephone the undersigned at the indicated number.

Dated:

Respectfully submitted,

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